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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 10/056,905  | 11/13/2001  | Jurgen Bussert       | A34729 (071308.0250) | 2357             |
| 21003   | 7590        | 06/28/2005           | EXAMINER             |                  |
| BAKER & BOTTS<br>30 ROCKEFELLER PLAZA<br>NEW YORK, NY 10112 |             |                      | ARANI, TAGHI T       |                  |
|   |             |                      | ART UNIT             | PAPER NUMBER     |

2131

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/056,905

Applicant(s)

BUSSERT, JURGEN

Examiner

Taghi T. Arani

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/13/2001.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 11/13/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/25/2003.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-16 have been examined and are pending.

***Information Disclosure Statement***

2. An initialed and dated copy of Applicant's IDS form 1449 filed November 25, 2003 is attached to the instant Office action.

***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

***Drawings***

4. The drawings are objected to because some of the descriptive labels are not in English. The English alphabet must be used for letters, except where another alphabet is customarily used, such as the Greek alphabet to indicate angles, wavelengths, and mathematical formulas, see 37 CFR 1.84(p)(2). Descriptive labels other than numerical are needed for figures, see 37 CFR 1.84(o). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application.

***Specification***

5. The disclosure is objected to because of the following informalities:

In page 3, paragraph 0004, the specification refers to Figure 1. There is no Figure 1 label in the drawings. Appropriate correction is required.

In page 3, paragraph 0005, line 1, the term “develops” should be corrected to “develop”.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1 –16 are rejected under 35 U.S.C. 101 because the “development system” and “development device” recited in claims 1 and 8 are described as computer programs (specification, page 3, paragraph 005). The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claims 2-7 and 9-16 are dependent on claims 1 and 8 respectively, and therefore inherit the 35 U.S.C. 101 issues of the independent claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,978,476 to Redman et al. (hereinafter “Redman”).

**As per claims 1 and 8**, Redman teaches a method and a system for transferring control programs comprising encrypting a control program code in a first development system (Figure 2 and associated text, col. 5, lines 10-19, i.e. generation of encrypted design file, see also col. 10, lines 54-59, the vendor encrypts his design file (control program) using a design file encryption system), transferring the encrypted control program code from the first development system to a second development system (col. 4, lines 41-45, the vendor creates the encrypted design file 103 makes it freely available via download on the World Wide Web), and decrypting the encrypted control program code in the second development system (Figure 4 and associated text, col. 6, line 65 67, col. 7, lines 27-29, decryptor 403 within the permission verification system 109 decrypts the authorization code 115 and decodes the encrypted design file using the design decryption key).

**As per claims 2 and 9**, Redman teaches the method and the system according to claims 1 and 8 respectively, further comprising exporting the encrypted control program code in a format that can be read by standard Internet clients via the first development system, and importing a data in the format that can be read by standard Internet clients via the second development system (col. 4, lines 41-45, the encrypted design file can be freely available via download on the World Wide Web (i.e. Standard Internet clients)).

**As per claims 3 and 10**, Redman teaches the method and the system according to claims 1 and 8 respectively, wherein the encryption and decryption of the data is carried out by means of asymmetrical keys (col. 5, lines 32-33).

**As per claim 4**, Redman teaches the method according to claim 1, wherein the encryption of the control program code is carried out following editing of the control program code in the first development system (Figure 2, file header assembler 209 (editor), col. 5, line 63 through col. 6, line 23, accepts information and generate tags A and B to be placed in a file header into the encrypted design file, prior to encrypting the design file (control program)).

**As per claim 5**, Redman teaches the method according to claim 1, wherein the decryption of the encrypted control program code is carried out following editing of the encrypted control program code in the second development system (col. 7, line 55 through col. 8, line 17, design processor 413 performs steps P, Q, R, S, T and U (i.e. editing of the encrypted design file) prior to decrypting the encrypted design file).

**As per claims 6 and 13**, Redman teaches the method and the system according to claims 1 and 8 respectively, wherein only a part of the control program is encrypted (col. 5, line 63-66, i.e. the file header (unencrypted) is appended to encrypted design file (col. 6, lines 27-28)).

**As per claims 7**, Redman teaches a method and for the configuration, project engineering and commissioning of a control system and a drive comprising transferring a control program according to claim 1, compiling the decrypted control program, and processing the compiled control program by means of a microprocessor (Figure 5 and associated text, compiler 503, col. 8, line 64 through col. 9, line 3. performs requested actions for which the user has permission.).

**As per claim 11**, Redman teaches the system according to claim 8, wherein the first development device further comprises an editor for editing the control program code (col. 5, line 63 through col. 6, line 23, i.e. a file header assembler (editor)) and a communication device (col. 4, lines 44-46, Redman discloses that encrypted design file 103 is freely available to the public via download on the World Wide Web (i.e. a communication device)) and a postprocessor (Figure 2 and associated text, i.e. ENCRYPTOR 203 encrypts design files after assembler (editor) accepts information and generate tags A and B to be placed in a file header into the encrypted design file) for encrypting the control program code connected between said editor and communication device.

**As per claim 12**, Redman teaches the system according to claim 8, wherein the second development device further comprises an editor (Figure 4 and associated text, col. 7, line 55 through col. 8, line 17, design processor 413 performs steps P, Q, R, S, T and U (i.e. editing of the encrypted design file) for editing the control program code, a preprocessor for decrypting the control program code (Figure 4, Decryptor 409), and a communication device (col. 4, lines 44-46, Redman discloses that encrypted design file 103 is freely available to the public via download on the World Wide Web (i.e. a communication device)), wherein said editor (design processor 413) is connected between the preprocessor and the communication device (col. 8, lines step w discloses that Decryptor 409 (preprocessor) decrypts the encrypted design file after the design processor (editor) performs editing steps P to U (col. 7, line 65 through col. 8, line 17)).

**As per claim 14**, Redman teaches the system according to claim 8 utilized in an arrangement for the configuration, project engineering and commissioning of a control system and/or a drive (col. 1, lines 18-32, Redman discloses the implementation of his invention in the area of Electronic Logic Design where the designers of logic devices program programmable logical devices).

**As per claims 15 and 16**, Redman teaches a method and a system according to claims 6 and 13 respectively, wherein a head part of the control program remains unencrypted (col. 5, line 63-66, i.e. the file header (unencrypted) is appended to encrypted design file (col. 6, lines 27-28)).

### ***Conclusion***

8. Prior arts made of record, not relied upon:

US Pub. No. 20020004804 to Nuenzel addresses Problems associated with handling industrial automation control code created using graphical programming languages.

USP 6,470,235 to Kasuga et al. teach an authoring system where a user creates and edits a scenario for a robot by using a GUI screen and a mouse. An authoring tool converts the scenario into a mnemonic code called "RCODE". When an RCODE action-control program is debugged, the RCODE program is extracted and encrypted step by step. The encrypted program is sequentially transferred to the robot by means of radio communication. The interpreter of the robot performs debugging by sequentially interpreting and executing the transferred program.



USP 6,487,665 to Andrews et al. is directed to an object-based security framework for intra-process security boundaries. An application developer can define security settings declaratively at the object, interface, and method level using a graphical interface. When the application is deployed, the settings are placed into a central store and can be modified at a later time. At runtime, logic outside the application objects enforces the security boundaries, relieving the developer of having to incorporate security logic into the application. Changes to the security can be implemented by changing the settings without having to change the application objects. In addition to checking for identity, the security framework supports roles and enforces specified authentication levels. The integrity of an application's security scheme is retained when the application is combined with another application in the framework.

USP 6,631,512 to Onyeabor is directed a system and method for Web page development, deployment, download, and execution which include and utilize a Web page development computer, a server computer, and a client computer.

USP 6,681,212 to Zeng discloses a protection mechanism to restrain software to a designated machine.


USP 6,697,942 to L'Heureux et al. discloses a data formatting method for embedding diverse data types in an electronic mail message which includes the step of forming a network compliant electronic mail message header.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (571) 272-3787. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Examiner  
Art Unit 2131  
6/25/05